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REMARKS

Claims 1-25, all the claims pending in the application, stand rejected on prior art grounds.

Claims 1, 17, 20, 21, 24, and 25 are amended herein. Applicants respectfully traverse these rejections based on the following discussion.

**I. The Prior Art Rejections**

Claims 1, 8-9, 11, 17-18, 20-22, and 24-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Weeks (U.S. Patent No. 6,338,057), in view of Kobayashi et al. (U.S. Patent No. 6,654,742), hereinafter referred to as "Kobayashi". Claims 2-7, 10, 12, and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Weeks, in view of Kobayashi, in further view of Official Notice. Claim 19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Weeks, in view of Kobayashi, in further view of Jacobson et al. (U.S. Patent No. 6,167,397), hereinafter referred to as "Jacobson". Claims 13-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Weeks, in view of Kobayashi, in further view of Jacobson, and in further view of Official Notice. Applicants respectfully traverse these rejections based on the following discussion.

The claimed invention, as provided in independent claims 1, 17, 20, and 21 contain features, which are patentably distinguishable from the prior art references of record. First, the rejection of claims 1-16 under 35 U.S.C. §103(a) are prima facie deficient because page 2, paragraph 7 of the Office Action rejects independent claim 1 based on the combination of Weeks and Kobayashi. However, page 3 of the Office Action uses Jacobson to reject claim 1. Accordingly, the rejections to claims 1-16 are improper.

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With respect to claims 1, 17, 20, and 21 and the claimed language “wherein identifying a pattern includes setting an attribute and searching for said attribute near to an occurrence of at least a part of said search statement in web pages of said results set,” the Office Action cites Jacobson (column 2, lines 7-9) as teaching this. Aside from the deficiencies of using Jacobson to reject the Applicants’ claimed invention as indicated above, even if Jacobson were properly considered, it would still fail to teach the elements of the Applicants’ claimed invention because nowhere in the Applicants’ claims are document pairs recited. In fact, the Applicants are not comparing document pairs, but rather are creating a search result based on patterns identified by the presence of a point query. Secondly, Jacobson bases its comparison on the occurrence of infrequently occurring words. However, nowhere in the Applicants’ claims are “infrequently occurring words” (or any analogous terms) used. Rather, the Applicants’ “attribute” is not so limiting, and in fact, may be frequently occurring words or numbers. Therefore, Jacobson does not teach this aspect of the Applicants’ claimed invention.

Next, page 4 of the Office Action indicates that it would have been obvious that “upon detection of a point query, which alternatively means a recurring search event is absent, returns the ordered results set without need for further pattern detection.” However, the Applicants’ claimed invention does provide for additional pattern detection, and that is “identifying noise patterns when a recurring search event is not present.” Accordingly, identifying noise patterns does, in fact, provide additional pattern detection, which is contrary to what the Office Action deems that someone of ordinary skill in the art would find obvious. Therefore, the Applicants’ claimed invention is patentable over the purported obviousness concluded in the Office Action.

Next, the Applicants’ point query may include words, letters, characters, or numbers (i.e.,

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alphanumeric characters). However, the quoted language on page 3 of the Office Action (citing Weeks) only refers to words. Accordingly, Weeks does not teach the Applicants' claimed invention.

Next, page 3 of the Office Action does not indicate which prior art reference purportedly teaches, "if said point query is present, accepting said ordered results set;" which is provided in Applicants' independent claims 1 and 20. Rather, page 3 of the Office Action merely states that it would have been obvious to one of ordinary skill in the art. However, it is not clear whether the Office Action is taking Official Notice of this fact, or whether the prior art is being used to teach these features. If Official Notice is being taken, then the Applicants respectfully make a demand of evidence that supports the position in the Office Action of this fact. Alternatively, if Official Notice is not being taken, the rejection is improper as not indicating how/where the prior art teaches this feature, which would supposedly be obvious to one of ordinary skill in the art.

Amended independent claims 1, 17, 20, and 21 contain features not taught or suggested in the prior art references of record. Specifically, amended independent claims 1, 17, 20, and 21 recite, in part, "..., wherein said point query comprises alphanumeric characters;...; identifying noise patterns when a recurring search event is not present...." Furthermore, such features would be unobvious with the combined teachings of Weeks, Kobayashi, Jacobson, and Official Notice.

With respect to the limitations that "wherein said recurring search event occurs when keywords appear in said results set are within 10-15 words before or after occurrences of said search statement," the prior art is also deficient in teaching this feature because page 7 of the Office Action merely takes Official Notice of this. Accordingly, the Applicants respectfully

make a demand of evidence that supports the position in the Office Action that teaches the exact range of 10-15 words before or after occurrences of a search statement. The Applicants challenge the conclusion reached in the Office Action that such a range would be obvious to one of ordinary skill in the art because none of the prior art references themselves teach this, when surely they could have. Accordingly, this range is a novel aspect of the Applicants' claimed invention because it provides a range that others might consider non-obvious. For example, most others might use a smaller range of 3-5 words perhaps due to limitations in processor speeds. Therefore, the Applicants' cited range is non-obvious over the prior art and/or Official Notice.

Applicants reiterate that insofar as references may be combined to teach a particular invention, and the proposed combinations of Weeks, Kobayashi, Jacobson, and Official Notice, case law establishes that, before any prior-art references may be validly combined for use in a prior-art 35 U.S.C. § 103(a) rejection, the individual references themselves or corresponding prior art must suggest that they be combined. There is nothing in each of the references that suggests the motivation to combine as suggested in the Office Action. In fact, had such a motivation been anticipated in any of the prior art references, then surely some discussion regarding alternative embodiments or manners of combination would have been suggested or at least inferred in any of the prior art references. In fact, no suggestion for combination is provided in any of the prior art references.

In In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983), the court stated: "[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings." Furthermore, the court in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (C.A.F.C.

1988), stated, “[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art must suggest the desirability and thus the obviousness of making the combination.” There is nothing in the prior art that refers to a suggestion or desirability of making the proposed combination. Accordingly, the rejection under 35 U.S.C. §103(a) is *prima facie* defective.

In the present application, the reason given to support the proposed combination is improper, and is not sufficient to selectively and gratuitously substitute parts of one reference for a part of another reference in order to try to meet, but failing nonetheless, the Applicants' novel claimed invention. Moreover, there is nothing in the prior art references themselves, namely Weeks, Kobayashi, Jacobson, and Official Notice, which suggests a motivation to combine elements from each reference in a manner consistent with the suggestion by the Office Action. Furthermore, the claimed invention meets the above-cited tests for obviousness by including embodiments such as “wherein said point query comprises alphanumeric characters; ...and...identifying noise patterns when a recurring search event is not present.” As such, all of the claims of this application are, therefore, clearly in condition for allowance, and it is respectfully requested that the Examiner pass these claims to allowance and issue.

As declared by the Federal Circuit:

In proceedings before the U.S. Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) citing *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Here, the Examiner has not met the burden of establishing a prima facie case of obviousness. It is clear that, not only does Weeks fail to disclose all of the elements of the claims of the Applicants' invention, particularly, the point query comprising alphanumeric characters and the identification of noise patters when a recurring search event is not present, as discussed above, but also, if combined with Kobayashi, Jacobson, and Official Notice in various combinations thereof, fails to disclose these elements as well. The unique elements of the claimed invention are clearly an advance over the prior art.

The Federal Circuit also went on to state:

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. . . . Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Fritch at 1784-85, citing In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Here, there is no suggestion that Weeks, alone, or in combination with Kobayashi, Jacobson, and Official Notice teaches a structure and method containing all of the limitations of the claimed invention. Consequently, there is absent the "suggestion" or "objective teaching" that would have to be made before there could be established the legally requisite "prima facie case of obviousness." In view of the foregoing, the Applicants respectfully submit that the collective cited prior art do not teach or suggest the features defined by amended independent claims 1, 17, 20, and 21 and as such, claims 1, 17, 20, and 21 are patentable over Weeks, alone, or in combination with Kobayashi, Jacobson, and Official Notice. Further, dependent claims 2-

16, 18-19, and 22-25 are similarly patentable over Weeks, alone, or in combination with Kobayashi, Jacobson, and Official Notice, not only by virtue of their dependency from patentable independent claims, respectively, but also by virtue of the additional features of the invention they define. Thus, the Applicants respectfully request that these rejections be reconsidered and withdrawn. Moreover, the Applicants note that all claims are properly supported in the specification and accompanying drawings. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.

## **II. Formal Matters and Conclusion**

With respect to the rejections to the claims, the claims have been amended, above, to overcome these rejections. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections to the claims.

In view of the foregoing, Applicants submit that claims 1-25, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.


Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary. Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-0441.

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Respectfully submitted,

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